



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/817,704	08/25/1997	ANTHONIUS J. SWAAK	P8214-7002	8580

7590

09/30/2002

ARENT FOX KINTER PLOTKIN & KAHN, PLLC
1050 CONNECTICUT AVENUE, N.W.
SUITE 600
WASHINGTON, DC 20036-5339

EXAMINER

EWOLDT, GERALD R

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 09/30/2002

95

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/817,704

Applicant(s)
Swaak

Examiner
G.R. Ewoldt

Art Unit
1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 22, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 20, 23-26, and 31-35 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 20, 23-26, and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's amendment, filed 7/22/02, has been entered.
2. Claims 18, 20, 23-26, and 31-35 are currently pending in this application.
3. In view of Applicant's amendment and response, filed 7/22/02, the previous rejection under the first paragraph of 35 U.S.C. 112 for the recitation of "morning stiffness pain" has been withdrawn.
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:
A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
6. Claims 18, 20, 23-26, and newly added Claims 32-33, stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Toshihide et al. (of record), for the reasons of record as set forth in Papers No. 27 and 30, mailed 5/21/01 and 1/25/02, respectively.

Applicant arguments, filed 7/22/02, have been fully considered but are not found persuasive. Applicant argues that "Neither of the cited references teaches the identification of a

patient suffering from morning stiffness, loss of grip strength, painful joints, or swollen joints or a patient in need of amelioration of erythrocyte sedimentation rate or C-reactive protein level. Thus since at least one required step is missing from each cited reference, neither cited reference anticipates nor would have rendered obvious the presently claimed invention." It is the Examiner's position that the instant claims have been amended to merely recite the classic signs and symptoms of rheumatoid arthritis (RA); as the prior art teaches the steps of administering erythropoietin (EPO) to an RA patient, the instant application comprises only the further characterization of a method taught by the prior art. If said method results in the alleviation of the recited signs and symptoms of RA, said alleviation would comprise an inherent property of the method taught by the prior art. Thus, the methods of the instant claims are not patentably distinct.

7. Claims 18, 20, 23-26, 31, and newly added Claims 32-33, stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pettersson et al. (of record), for the reasons of record as set forth in Papers No. 27 and 30, mailed 5/21/01 and 1/25/02, respectively.

See the Examiner's position regarding the prior art rejections in paragraph 6 above.

8. The following are New Grounds for Rejection.

9. Claims 18, 20, 23-26, 31, and newly added Claims 32-33, are rejected under 35 U.S.C. 102(b) as anticipated by Swaak et al. (1994).

Swaak et al. teaches a method of treating swollen joints and ameliorating C-reactive protein level in an RA patient comprising administering an effective amount of recombinant human EPO to a patient in need of said treatment or amelioration (see entire Abstract).

The reference clearly anticipates the claimed invention.

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with

Serial No.: 08/817,704
Art Unit: 1644

4

which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 34 and 35 are rejected under 35 U.S.C. § 112, first paragraph, as the specification does not contain a written description of the claimed invention, in that the disclosure does not reasonably convey to one skilled in the relevant art that the inventor(s) had possession of the claimed invention at the time the application was filed. This is a new matter rejection.

The specification and the claims as originally filed do not provide support for the invention as now claimed, specifically, a method wherein "the treatment period is 3 to 6 weeks."

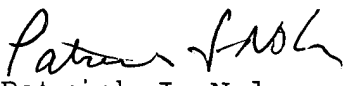
Applicant's amendment, filed 7/22/02, asserts that no new matter has been added. However, no support for the specific time period limitation has been found in the specification.

12. No claim is allowed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday and alternate Fridays from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The CM1 Fax Center telephone number is (703) 305-3014.

G.R. Ewoldt, Ph.D.
Patent Examiner
Technology Center 1600
September 26, 2002


Patrick J. Nolan, Ph.D.
Primary Examiner
Technology Center 1600